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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEX P. JANSEN and MUKUND PATEL

Appeal 2010-004969
Application 10/623,381
Technology Center 3700

Before ROMULO H. DELMENDO, RICHARD M. LEBOVITZ, and
JEFFERY B. ROBERTSON, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL¹

This is a decision on the appeal under 35 U.S.C. § 134 by the Patent Applicant from the Patent Examiner's rejections of claims 25 and 31. The Board's jurisdiction for this appeal is under 35 U.S.C. §§ 6(b). We affirm.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Claims 7-32 are pending and stand rejected by the Examiner (Final Office Action mailed January 12, 2007). However, in the Appeal Brief, Appellants only appealed the rejection of claims 25 and 31 (App. Br. 2). As Appellants did not appeal the rejection of claims 7-24, 26-30, and 32, we do not have jurisdiction over these claims. *Ex parte Ghuman*, 88 USPQ2d 1478, 1480 (BPAI 2008 May 1, 2008)(precedential). Upon return of this appeal to the Examiner, the Examiner may cancel the unappealed claims or direct Appellants to do so.

Claims 25 and 31 stand rejected under 35 U.S.C. § 103(a) as obvious in view of Thomas '075² or Thomas '463³ (Answer 3 & 4). The Examiner additionally cited Scales,⁴ Scribner,⁵ and Vandewalle⁶ as evidence (*id.* at 4).

Claim 31 is representative and reads as follows (with claim 7 and 11 upon which claim 31 depends):

7. A kit for treating a bone structure having a cavity, comprising:
a plurality of biocompatible, unconnected, implantable, laterally resilient wires; and
a cannula configured for introducing the wires within the cavity of the bone structure in a web-like arrangement.

² Thomas, Jr., U.S. Patent Application Publication US 2003/0074075 A1, filed Aug. 27, 2002.

³ Thomas, Jr., U.S. Patent Application Publication US 2004/0024463 A1, filed Apr. 18, 2003.

⁴ Scales, U.S. Patent 4,405,249, issued September 20, 1983.

⁵ Scribner, U.S. Patent 6,241,734 B1, issued June 5, 2001.

⁶ Vandewalle, U.S. Patent Application Publication US 2004/0153090 A1, filed Feb. 3, 2003.

11. The kit of claim 7, further comprising a device configured for applying uncured bone cement onto the web-like arrangement of wires.

31. The kit of claim 11, wherein the device is a spraying device.

ISSUE

Would it have been obvious to a person of ordinary skill in the art to have used a sprayer device to spray bone cement on the implant of Thomas '075 or Thomas '463?

LEGAL PRINCIPLES

[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. Sakraida and Anderson's-Black Rock are illustrative – a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 417 (2007).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”
Id. at 416.

CLAIM INTERPRETATION

The disputed claim limitations in this appeal are the terms “spraying device” as recited in claim 31 and “sprayed onto” as in claim 25.⁷ According to the claims, the spraying device is used to apply (“spray”) bone cement on to the resilient wires introduced into a bone cavity. The Specification does not define either of the terms, although it indicates that “spraying” is one way in which bone cement is applied to the wires to stabilize them (Spec. 4: 7-21). The Specification states that the spraying device “can be operated to provide a spray or mist of the uncured bone cement . . . in order to coat and facilitate stabilization of the web-like arrangement of support wires” (*id.* at 8: 20-22). “Preferably, the uncured bone cement 110 exhibits a relatively low viscosity to allow it to be sprayed into a mist.” (*Id.* at 8: 16-18).

Relying on a dictionary definition, the Examiner interpreted “spray” to mean “‘a fine jet of liquid discharged from a pressurized container.’” (Answer 3.) We adopt this definition for the purpose of comparing the scope of claims 25 and 31 to the cited prior art.

FINDINGS OF FACT

Thomas ‘075

1. Thomas ‘075 describes an expandable bone implant for repairing an intervertebral disc (Abstract).
2. “Bone cement, such as methyl methacrylate or other synthetic polymers, can also be used.” (¶ 118.)

Thomas ‘463

⁷ See Claim appendix of the Appeal Brief for claim 25.

3. Thomas '463, a continuation-in-part application of Thomas '075, describes a bone implant (Abstract).
4. "Bone cement, such as methyl methacrylate or other synthetic polymers, can also be used." (¶ 140.)

Scales

5. Scales describes a syringe for dispensing a "viscous material which is flowable under pressure" and which "is particularly applicable to expressing bone cement" (col. 1, ll. 5-14; Fig. 2).

Scribner

6. Scribner describes a syringe to expel bone cement material through a nozzle 106 into a cavity (Abstract; col. 16, ll. 14-32; Figs. 27-28).
7. Scribner teaches that the material may be delivered at a low delivery pressure (col. 10, ll. 26-35).

Vandewalle

8. Vandewalle describes an apparatus for applying a material to a selected area within a bone (¶ 6).
9. The apparatus comprises a reservoir and a nozzle to direct the material into the bone (*id.*)
10. The material is disclosed to be a platelet concentrate or bio-active material (¶¶ 6 & 7).
11. Fig. 2 of Vandewalle shows a syringe-like device with a nozzle at its outlet end.
12. "The nozzle 42 may be any appropriate shape or size to selectively direct the spray S." (¶ 23.)

ANALYSIS

The Examiner found that each of Thomas '075 and Thomas '463 described applying bone cement to a bone implant (Answer 3-4). The Examiner found that a device for applying the bone cement was “implied” by the disclosure that bone cement could be used on the implant (*id.*). Defining spray to mean “a fine jet of liquid discharged from a pressurized container,” the Examiner determined it would have been obvious to person of ordinary skill in the art to deliver bone cement by a fine jet in order to minimize the incision size into the bone through which the bone cement is administered (*id.*). In response to Appellants’ argument that the Examiner did not provide evidence of where a “pressurized device” had been “used to discharge bone cement in a fine jet of liquid” (App. Br. 4), the Examiner cited the Scales, Scribner, and Vandewalle patents for describing devices capable of spraying material onto a bone (Answer 4)

Appellants contend that the Examiner did not “set forth any reason why a bone cement spraying device introduced through the cannula would minimize an incision size as compared to any other device used to introduce bone cement through the same cannula.” (App. Br. 4). Appellants acknowledged that the Thomas publications, “along with any of this other prior art, suggests” filling the bone cavity with bone cement, but contend the publications do not describe “spraying bone cement on a web-arrangement of wires for this reason or for any other reason.” (*Id.* at 4-5). Appellants contend that neither Scales nor Scribner disclose that bone cement is sprayed, but rather describe it as being ejected or applied in a stream (Reply Br. 3). As to Vandewalle, Appellants contend that the Examiner has not shown that Vandewalle is a prior art reference. They argue that Vandewalle

was published well after the filing date of the present application, and the claimed subject matter was invented prior to the filing date of the Vandewalle application (*id.*) Because Vandewalle was newly cited in the Answer, Appellants contend they were not given an opportunity to show that the claimed subject matter was invented prior to Vandewalle's filing date (*id.* at 3-4).

Appellants' arguments are not persuasive. Scales and Scribner describe devices for applying bone cement to a bone implant by pressure (FF5-7). Vandewalle describes a device for applying a bioactive material (FF8-12). Using a known device for its "established" function is obvious when it yields predictable results. *KSR*, 550 US at 416 & 417. The use of the devices described in the Scales, Scribner, and Vandewalle appears to be a "predictable" use of a known prior art device in the Thomas method, making it obvious to persons of ordinary skill in the art.

Appellants contend that neither Scales nor Scribner disclose that bone cement is sprayed, but rather describe it as being ejected or applied in a stream (Reply Br. 3). Appellants attempt to distinguish the claimed invention from Scales and Scribner by the characteristics of the bone cement delivered through the device nozzle.

The Examiner interpreted "spray" to mean a "jet of liquid." A "jet" is not limited to a "mist," but would cover other forms in which a liquid was expelled by a device, such as in a stream or in spurts. The claim does not require the sprayer to be equipped with particular nozzle size or shape that would produce a "jet" with specific characteristics when expelled through it. Accordingly, the Examiner's finding that the liquid expelled by pressure

from the devices of Scales and Scribner meets the claimed limitation of a spray is consistent with the claim's broadest reasonable interpretation.

Scribner, Scales, and Vandewalle were cited in the rejection for the first time in the Examiner's Answer. The Examiner introduced these references to show known bone spraying devices. The Examiner explained that these references had not previously been cited because Appellants had not previously raised the issue that the prior art was deficient in failing to describe a spraying device (Answer 4-5.) Appellants contend that, in introducing these references, the Examiner provided a new basis for the rejection (Reply Br. 1):

Appellant is not forbidden from presenting arguments in an appeal that were not made prior to the issuance of a final office action. Indeed, it is the Examiner's obligation to support all rejections made during the prosecution of the application, and if Appellant has pointed out the insufficiency of a rejection during an appeal, Appellant should not somehow be placed at a disadvantage because of this.

(*Id.* at 2.)

According to the Manual for Patent Examining Procedure (MPEP, Eight Edition, August 2001; revision July 2010,) § 1207.03(IV):

If appellant believes that an examiner's answer contains a new ground of rejection not identified as such, appellant may file a petition under 37 CFR 1.181(a) within two months from the mailing of the examiner's answer requesting that a ground of rejection set forth in the answer be designated as a new ground of rejection. Any such petition must set forth a detailed explanation as to why the ground of rejection set forth in the answer constitutes a new ground of rejection. Any allegation that an examiner's answer contains a new ground of rejection not identified as such is waived if not timely raised (i.e., by filing the petition within two months of the answer) by way of a petition under 37 CFR 1.181(a). The filing of a petition under

37 CFR 1.181 does not toll any time period running. If appellant wishes to present arguments to address the rejection in the examiner's answer, appellant must file a reply brief to the examiner's answer within two months from the mailing date of the examiner's answer.

As the question of whether the Examiner made a new ground of rejection is a petitionable matter, it is not within our jurisdiction to decide whether it was warranted under these circumstances. Moreover, based on the evidence before us, Vandewalle qualifies as prior art under 35 U.S.C. § 102(e) as a result of its filing date of February 3, 2003, which is prior to Appellants' filing date of July 18, 2003.

In sum, we affirm the obviousness rejection of claims 25 and 31.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

ack

cc:

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